

Remarks

Claims 7, and 17 were pending in the above-identified application when last examined. Claim 7 is amended to correct an informality. New claims 19-24 are added. Claims 7, 17, and 18-24 are presented for consideration and allowance.

Claim Objections

The Examiner objected to claims 7 and 17 because of informalities. The phrase "...wherein said transparent cap comprises a spherical surface of constant thickness" should be "...wherein said transparent cap comprise a spherical surface and has a constant thickness." These informalities are corrected in amended claim 7.

The Examiner stated that claim 18 would not be examined because claim 18 was never presented officially during prosecution. Claim 18 is included for prosecution and allowance.

Claim Rejection under 35 U.S.C. § 102

Examiner rejected claims 7 and 17 under 35 U.S.C. 102(b) as being anticipated by Kawae et al., hereinafter Kawae (US Patent Application Publication 2002/0080501), or alternatively, under 103(a) as being unpatentable over Kawae in view of Lowery (US patent 5,959,316). Applicants respectfully traverses this rejection.

Applicants disagree with the Examiner's reading of Kawae. The Examiner

indicates that Figure 7's depiction of a varying cap thickness provides evidence that the depiction in Figure 9 of a cap with a constant thickness was intentional. Applicants submit that Figure 9 does not depict a cap with a constant thickness. Rather, Figure 9 depicts a thickness of indeterminate thickness. Nowhere in Kawae is it indicated that the cap in Figure 9 is constant thickness. Moreover, nowhere in Figure 9 is it indicated that the thickness is constant. Hence, Applicants submit that the Examiner has not shown that Kawae has shown that the cap has a constant thickness, as required by the limitations of claim 7.

Kawae does not disclose all the elements of claim 7. For at least this reason, Applicants request reconsideration and withdrawal of the rejection of claim 7 under 35 U.S.C. § 102(b).

Claims 17-24 depend from claim 7 and they are patentable for at least the same reasons as claim 7.

Claim Rejection under 35 U.S.C. § 103

Examiner rejected claims 7 and 17 under 35 U.S.C. 102(b) as being anticipated by Kawae et al., hereinafter Kawae (US Patent Application Publication 2002/0080501), or alternatively, under 103(a) as being unpatentable over Kawae in view of Lowery (US patent 5,959,316). Applicants respectfully traverses this rejection.

Appellants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness because, among other reasons, there is no suggestion or motivation to combine the reference teachings as proposed by the Examiner. In the

rejection, the Examiner asserts that all of the elements of applicants' claims can be found in the prior art references. This, however, is **not** the proper test for obviousness.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."

Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

The Examiner has provided no basis for a teaching or suggestion in the prior art for combining elements as proposed in the rejection. The Examiner's argument regarding obviousness is as follows:

... it would have been obvious to one of ordinary skill in the art at the time of the invention to make the cap in the Kawae reference as a spherical surface of constant thickness to avoid the annular ring problem.
(Office action, page 4)

The single sentence above represents the Examiner's only explanation regarding a teaching or suggestion to combine. This sentence, however, is simply an *unsupported statement* made by the Examiner. In order to establish a *prima facie* case, a teaching or suggestion to combine must be found *in the prior art*. See, e.g., *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, *supra*. Such an unsupported statement, however, cannot constitute the evidence required to establish existence of a motivation

or suggestion to combine:

Whether the Board relies on an express or an implicit showing [of a motivation, suggestion or teaching to modify the teachings of a reference], it must provide particular findings related thereto.... Broad conclusory statements standing alone are not "evidence".

In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999))

Accordingly, the Examiner's statement does not constitute a showing of a teaching or suggestion to combine. In the present case, however, the Examiner provides no evidence that the requisite knowledge is generally available but, instead, attempts to rely on his own personal opinion. Such personal opinion does not represent an adequate substitute for evidence.

In short, it appears that the Examiner's proposed combination of Kawae and Lowery is based solely on hindsight derived from applicants' specification. The use of hindsight in this manner is clearly prohibited by the relevant case law:

Obviousness can not be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). As discussed in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

In re Dance, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)

Obviousness may not be established using hindsight. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection of claim 7 under 35 U.S.C. § 103(a).

Claims 17-24 depend from claim 7 and they are patentable for at least the same reasons as claim 7.

Conclusion

Applicants respectfully submit that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby requested.

Respectfully submitted,

July 17, 2007

/John Pessetto/

John R. Pessetto, Reg. No. 48,369
KLAAS, LAW, O'MEARA & MALKIN, P.C.
P.O. Box 1920
Denver, Colorado 80201-1920
Tel. (303) 298-9888
Fax (303) 297-2266